



# DESIGNS DIGEST 2018

Bird & Bird rounds up Europe's most recent notable design-related decisions

## Belgium

### DAMAGES RESTRICTED FOR UNREGISTERED DESIGNS

In *Kozmoz Design & Display v Eurodisplay* (12th March 2018, A/03515/2015), the Brussels Community Design Court held that Eurodisplay infringed Kozmoz's unregistered Community design rights in a display. The Court found that Eurodisplay had used an identical design, and it issued a cease-and-desist order in Kozmoz's favour.

Despite this decision, the Court did not award any damages as a result of the infringement. Pursuant to Article 88(2) of the Community Design Regulation (Council Regulation (EC) No 6/2002) (CDR) and CJEU case law (*Gautzsch Großhandel*), in all matters not covered by the regulation (including damages compensation), Community Design Courts should apply national law. In Belgium, designs are governed by the Benelux IP Convention, which offers no protection for unregistered designs. Consequently, there is no basis for claiming damages as a result of infringing an unregistered Community design in Belgium.

Article 96 CDR does allow for full compatibility with other types of national design protection. Provided they are original, utility products such as displays are eligible for copyright protection and damages awards under Belgian law. Hence, having established the originality of the design at issue, the Brussels Court did grant compensation in the amount of €7,500 (evaluated *ex aequo et bono*) for copyright infringement.

Report: Alizée Jolie and Domien Op de Beeck

## France

### SHINY SHOE HAS INDIVIDUAL CHARACTER

In *StudioA Sarl v Minelli SAS* (4th May 2018, RG 2017/06372: D20180029), the Paris Court of Appeal considered that the details of a sandal constituted individual character.

StudioA, a retailer of flat wedge sandals, sued Minelli for infringement following Minelli's attempt to file a design that StudioA considered similar to its own. Minelli argued that the StudioA shoe was not "new" and was devoid of "individual character", because it was an imitation of a sandal by designer Véronique Branquinho.

The Court of Appeal considered that the shiny aspect on StudioA's sandal conferred a chic look, while the matte Branquinho model had a casual aesthetic. It considered that

the shiny aspect contrasted with the natural look of the sole, while the Branquinho sandal was monochrome. Finally, the Court noted that the buckle of the StudioA model was the same colour as the bridle and had a release at the front that was more accentuated than that of the Branquinho sandal.

The Court found that these visual elements conferred a distinctive appearance on StudioA's sandal, and that a well-informed consumer would easily be able to distinguish it from other designs.

Nevertheless, the impact of this decision remains uncertain, as the decisions rendered by the courts on first hearing are, for the most part, not in accordance with it.

Report: Elsa Lavaud



Branquinho design



StudioA design



# Germany

## EYEWEAR DECISION NOT BLACK AND WHITE; BALLERINASCHUH TESTS SCOPE OF PROTECTION

In the Sportbrille proceedings (23rd November 2017, ECLI:DE:BPatG:2018:130418B30Wpat803.15), the German Federal Patent Court considered an invalidity application for a nationally registered ski goggle design. The design representation showed glasses with eyewear straps in different colour combinations. The Applicant argued that the design was devoid of unitary character, and that the application was inadmissible under s1(1) of the German Design Act, as it was an attempt to protect different versions of ski goggles with a single design. In particular, the goggle's frame was presented in both white and black, while the eyewear strap was presented in several colour combinations (black/light grey, white/black and black/dark grey).

The Court did not agree, and commented that the unitary character of the design was to be determined by interpretation of the application documents (ie classification and indication of products, representations of the design). The Court instead found that the unitary character and scope of protection followed from the identical characteristics between the different versions, and accordingly was limited

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to what was congruently depicted by the design representations. By using different greyscales, the proprietor validly defined the design's scope of protection, ie a pair of ski goggles determined by its shape, with colour combinations specified by grey tones.

Although this approach is advantageous for designs applicants, it may be a disadvantage for third parties that wish to reliably determine the scope of protection for a registered design by means of research. The decision is being appealed, so it remains to be seen whether the German Federal Court of Justice will agree with the initial Court's reasoning.

Meanwhile, in proceedings for Ballerinaschuh, the German Federal Court of Justice considered the issue of infringement (11th January 2018, I ZR 187/16, ECLI:DE:BGH:2018:110118UIZR187.16.0). The Spanish footwear manufacturer of a yellow ballerina shoe with a two-tone sole filed an action against the manufacturer of a similar model under its registered Community design. The latter manufacturer argued that the Plaintiff had released a similar model onto the market and on the internet before filing the Community design application. The Court found that the offer of a similar model on the Plaintiff's website, which was accessible in the EU, was part of the design corpus and needed to be taken into account when assessing the Plaintiff's registered Community design, irrespective of its actual distribution.

The registered Community design was therefore found to have a limited scope of protection due to prior publication of a similar model, and was not affected by the allegedly infringing ballerina shoe. However, the Court referred the case back to the Higher Regional Court of Düsseldorf for further evaluation as to whether claims under competition law pursuant to s4(3) of the German Unfair Competition Act should

be considered, and whether unlawfully offering replicas of the Plaintiff's ballerina shoe would unreasonably exploit or impair the Plaintiff company's reputation.

This decision may be important in cases where design registrations have not been obtained, or where the registrations are invalid or have only a limited scope of protection. When it comes to unfair competition law, the previously known design corpus is not of equal relevance and, in contrast to design law, a similar product previously distributed by a company can sometimes increase the individual character of a subsequent product marketed by the same company.  
*Report: Roman Brtka*





## Italy

### “FAST FASHION” BEWARE

The Court of Milan recently confirmed that a Community Design Court may award damages at an EU-wide level for infringement of registered and unregistered designs (2nd July 2018, Docket No. 23303/2016).

In 2016, OTB (parent company of Diesel and Marni) brought an action against the Zara group, claiming that the latter had infringed Diesel’s registered Community design and related unregistered design for the Skinzee-sp women’s jeans; and Marni’s unregistered Community design right for the Fussbett sandal.

The Court found that Zara had infringed the above design rights and ordered an interim injunction in favour of OTB. Earlier this year, the Court of Milan, in its capacity as a Community Design Court, upheld the interim injunction.

The Court held that it would have jurisdiction over Zara,

despite the company being established abroad, under Article 8(1) of the recast Brussels I. The Court noted that Zara’s Spanish companies operated in the same production and commercial chain as OTB’s products traded in Italy.

Zara contended that the Italian Court lacked jurisdiction to decide on the alleged infringement, which occurred outside Italy. The Court applied the principles set out by the CJEU in *Nintendo v Big Ben* – one of the first courts in Europe to do so – and found it had EU-wide jurisdiction to award remedies, including damages. As regards awarding damages, the Court held that, for the infringing activities carried out by the Spanish companies outside Italy, but within the EU, the applicable law would be Spanish law.

*Report: Fulvio Mellucci and Valeria Meli*



Above: Marni’s Fussbett design

Below: Diesel’s Skinzee-sp design



## The Netherlands

### TAKING THE ROUGH WITH THE SMOOTH

In light of the decision by the Hague Court of Appeal in *Arpe v Happy Cocooning* (20th February 2018, ECLI:NL:GHDHA:2018:272), a prospective rights holder should take care when choosing the drawings and pictures of a design it seeks to register.

The Court was required to consider whether Happy Cocooning’s registered design was infringed by Arpe’s gas heater. The Court assessed the overall impression of the gas heaters, and considered that the registered design had a clean, minimalistic appearance with a stony look in monochrome colour, whereas Arpe’s design had a messy, wooden aesthetic with discolorations and a lighter colour scheme.

Contrary to the provisional relief court in first instance, the Court ruled that these differences resulted in a different overall impression. Despite the registered design having a reasonably large scope of protection, the Court ruled that the design of the Arpe gas heater did not infringe the design rights of Happy Cocooning, and that the differences were more eye-catching than the similarities.

*Report: Manon Rieger-Jansen and Sabrina Lodder*



# Poland

## THE SHORT LIFE OF THE SPOTTED COW

The Polish Patent Office (PPO) recently decided that Zielona Budka's industrial design Rp.15331 infringed the rights of the well-known figurative trade mark R.119599, owned by Mlekpól, one of the biggest dairy-product producers in Poland (25th June 2018, Sp.68.2015).

The PPO's decision follows on from a long-standing dispute between the two large Polish ice-cream producers.

In 2015, Mlekpól filed an invalidation request against Zielona Budka's industrial design with the PPO, challenging the registration. It claimed that the so-called cow spots were a characteristic element of the well-known ŁACIATE trade mark, and that the use of spots in Zielona Budka's design infringed its rights. In its original judgment, the PPO found that the ice-lolly shape with irregular stripes did not contain any element of the ŁACIATE marks, in particular the "spots" layout, and dismissed the invalidation request.

Mlekpól appealed the PPO's decision before the Voivodeship Administrative Court in Warsaw (17th November 2016, ref. VI SA/Wa 1135/16). The Court overruled the first instance decision and indicated that the designer mentioned the cow spots specifically in the design description. The Court also noted that the graphic of the design constituted such a pattern, not just irregular stripes in white and brown colours.

The case was then re-examined by the PPO, which upheld the Court's stance and invalidated the industrial design Rp.15331 on the basis of infringement of third-party property rights.

Report: Anna Filonowicz



Zielona Budka's design, Rp.15331



Mlekpól's design, R.119599



# Spain

## DEFINING THE "INFORMED USER"

A decision of the Spanish Supreme Court (5th May 2017, No. 275/2017) has clarified the definition of an "informed user", a term set out in Spanish design law under Article 7 of Law No. 20/2003 on Legal Protection of Industrial Designs.

The object of the litigation included a design based on the traditional Catalanian *trencadís*, a mosaic technique often used by the architect Antoni Gaudí.

The designs at issue were being sold as souvenirs, a situation that led to the analysis of two types of "user": the mere tourist, who buys the item with minimal attention to detail (the consumer degree of attention normally assessed when judging trade mark cases); and the professional retailer of such products, whose professional due care and attention is part of its commercial activity.

The status of an "experienced user" in relation to Spanish

designs has also been further clarified by this decision, as the Court also considered contradictory concepts, such as "author freedom" for designs.

This definition follows the lead of the CJEU decision in *PepsiCo Inc v Grupo Promer Mon Graphic SA*, in which the "informed user" figure stands between the reasonable, circumspect consumer and the professional designer – a person who, due to their personal experience, may appreciate the singularity of the design per se.

Moreover, the decision refers to the necessity of establishing the nature of the object of the design, which will give way to the definition of "informed users", those linked to the professional sector to which the design pertains or those final users who are personally experienced and more attentive to the product characteristics.

Report: María Fernández

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